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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/001,389
Filing Date: October 23, 2001
Appellant(s): WIKE ET AL.

James D. Wood
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 May 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,594,228	SWARTZ ET AL	01-1997
5,469,142	BERGMAN ET AL	11-1995

2002/00096564A1	BELLIS, JR ET AL	7-2002
6,486,780	GARBER ET AL	11-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 8-9 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al (US 5,594,228) in view of Bergman et al (US 5,469,142); claims 5-7, 10-12 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al as modified by Bergman et al, and further in view of Bellis Jr. et al (US 2002/0,096,564A1); claims 13-14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al as modified by Bergman et al, and further in view of Garber et al (US 6,486,780 B1).

I. Claims 1-4, 8-9 and 15-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al (US 5,594,228) in view of Bergman et al (US 5,469,142).

Re claims 1-4, 8-9 and 15-16: Swartz et al discloses a system and method of operating of a self-checkout terminal comprising a scanner [10, 144] for scanning a tag 101 having a barcode symbol 103 of an item [102, 120]; an electronic article surveillance deactivator 100 operative to deactivate an active surveillance tag 126 by a consumer (figs. 9a-10b; col. 19, lines 59+; col. 22, lines 4+); a processor/microcomputer 164, having a memory for storing a database and program instructions, in communication with the scanner 144, causing the processor/microcomputer 164 to scan the item 120 for purchase via the scanner 144 and deactivate the active electronic article surveillance tag 126 (figs. 1 and 7a-9b; col. 10, line 29 through col. 12, line 10 and col. 18, line 4 through col. 21, line 17).

Swartz et al fails to teach or fairly suggest that the system further comprising an electronic article surveillance detector operative to detect whether a scanned item has an active electronic article surveillance tag, wherein the electronic article surveillance detector is associated with the scanner.

Bergman et al teaches an electronic article surveillance detector for determining whether an active electronic article surveillance tag is present at the checkout station (figs. 3-4b; col. 3, line 5 through col. 5, line 6).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an electronic article surveillance detector to detect a presence of an active electronic article surveillance tag as taught by Bergman et al into the self-checkout system of Swartz et al in order to provide Swartz et al with a more versatile system that has a capability of operating in all self-checkout systems (i.e., whether a surveillance tag is present or not). Furthermore, such modification would have been an obvious extension, well within the ordinary skill in the art, as taught by Swartz et al for a more feasible system that allows retailers to have surveillance tag on certain expensive items rather than having surveillance tag attached on every single item which can be very expensive, and therefore an obvious expedient.

II. Claims 5-7, 10-12 and 17-19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al as modified by Bergman et al as applied to claims 1, 8 and 15 above, and further in view of Bellis Jr. et al (US 2002/0,096,564A1). The teachings of Swartz et al as modified by Bergman et al have been discussed above.

Re claims 5-7, 10-12 and 17-19: Swartz et al/Bergman et al has been discussed above but fails to teach or fairly suggest that the system further comprising a second electronic article surveillance detector associated with a bagwell/security scale of the self-checkout and is operative

to determine whether the electronic article surveillance tag has been deactivated by the electronic article surveillance deactivator.

Bellis Jr. et al teaches a bagging station 270 including an electronic article surveillance monitor 300 for detecting the presence of an active electronic article surveillance tag and a security scale 290 (page 2, paragraph [0020]; page 4, paragraph [0042] through page 5, paragraph [0059]).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate an electronic article surveillance detector associated with the bagwell/security scale as taught by Bellis Jr. et al into the teachings of Swartz et al/Bergman et al in order to provide Swartz et al/Bergman et al with a capability of assuring that an active surveillance tag, which attached to a paid item is deactivated before brought out of the store in the event the lamp is malfunctioning (i.e., illuminating when an unsuccessful deactivation occurs), and thus eliminates fault detection (i.e., failure to deactivate a tag in an active state would set off an alarm when passing through a controlled exit).

III. Claims 13-14 and 20 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al as modified by Bergman et al as applied to claims 8 and 15 above, and further in view of Garber et al (US 6,486,780 B1). The teachings of Swartz et al as modified by Bergman et al have been discussed above.

Re claims 13-14 and 20: Swartz et al/Bergman et al has been discussed above but fails to teach or fairly suggest that the electronic article surveillance detector comprising a coil and electronic circuitry/logic that is operative to obtain a signal from the coil indicative of the active electronic article surveillance tag.

Garber et al teaches an electronic article surveillance detector system comprising a coil/an antenna 104, a circuitry/an interrogation source 102 and a detector 106 for obtaining a signal from the coil indicative of the active electronic article surveillance tag (col. 7, lines 3+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ a coil and electronic circuitry/logic as taught by Garber et al into the electronic article surveillance detector of Swartz et al/Bergman et al due to the fact that such modification would have been an obvious engineering design variation in an interrogation system, well within the ordinary skill in the art, for transmitting an interrogating signal to a transponder/surveillance tag that affixed to an article/item and for receiving a response signal from the tag, which would determine the presence of the tag, and therefore an obvious extension.

(11) Response to Argument

I. ISSUE 1:

A. First Claim Grouping: Appellant contends with respect to claim 1, which is directed to a method of operating a self-service checkout terminal.

Appellant's argument with respect to claim 1 that "no motivation to combine references" (page 6, line 3) ... "there is no need for the self-check apparatus of Swartz to ever incorporate a Bergman active electric surveillance tag detector..."(page 6, lines 15+) is not persuasive. Swartz et al discloses a system and method of operating of a self-checkout terminal comprising a scanner [10, 144], which allows consumer scanning of an item for purchase; an electronic article surveillance deactivator 100 operative to deactivate an active surveillance tag 126 by a consumer (col. 10, lines 62-68). Swartz et al further discloses "a check is made to verify that the surveillance tag is attached to an article which has been selected for purchase" (abstract, lines 7-9). However, Swartz et al is

silent with respect to a specific step of determining whether the item has an active electronic article surveillance tag (as recited in claim 1) in the checkout procedure of the specification. Bergman specifically teaches a step S9 (fig. 4a) for determining whether an active electronic article surveillance tag is detected (col. 3, lines 57-60). According, one of ordinary skill in the art would have recognized the addition of a specific step of determining the presence of an active tag as taught by Bergman into the self-checkout system of Swartz et al in order to assure that an active surveillance tag, which attached to a paid item is deactivated before brought out of the store to eliminate fault detection (i.e., failure to deactivate a tag in an active state would set off an alarm when passing through a controlled exit).

Appellant's argument with respect to claim 1 that "... the Examiner intended to state that a label need not be associated with a surveillance tag, the Examiner's interpretation is not reasonable..." (page 7, lines 15-16) is not persuasive. Swartz et al discloses a self-checkout system comprising a garment/item 120 having two tags (i.e., a hang tag 122 on which a symbol/barcode 124 is printed, and a surveillance tag 121 on which a symbol/barcode 128 is printed) (figs. 7a-7b; col. 18, lines 4+); the barcodes 124 and 126 can be different or identical (18, lines 12-14). When a consumer scans an item/garment for purchase via a scanner, the barcode 124 on the tag 122 is scanned (figs. 7a-7b), which identifies the item/product/garment; after a successful scanning and after a transaction approved, the consumer is instructed to present the surveillance tag for deactivating, at this time the barcode 128 on the surveillance tag 121 is scanned to determine whether the surveillance tag is actually belonged to one of the scanned/paid items, if the surveillance tag is identified as one of the paid items', the tag is deactivated (figs. 9a-12a). Swartz et al is silent with respect to a specific step of determining whether the item has an active electronic article surveillance tag (as recited in claim 1) before instructing the consumer to present the

surveillance tag for deactivating. Bergman teaches a step S9 (fig. 4a) for determining whether an active electronic article surveillance tag is detected (col. 3, lines 57-60). Accordingly, Swartz et al as modified by Bergman meets the limitation of the claimed invention.

Appellant's argument with respect to claim 1 that Swartz et al in view of Bergman fails to teach or fairly suggest that "a consumer be allowed to deactivate a surveillance tag after the step of determining whether or not a surveillance tag is present..." (page 8, line 15 through page 9, line 8) is not persuasive. Swartz et al discloses "a check is made to verify that the surveillance tag is attached to an article which has been selected for purchase" (abstract, lines 7-9). However, Swartz et al is silent with respect to a specific step of determining whether the item has an active electronic article surveillance tag (as recited in claim 1) before advices the consumer to deactivate the tag. Bergman specifically teaches a step S9 (fig. 4a) for determining whether an active electronic article surveillance tag is detected (col. 3, lines 57-60). As noted above, only the step of determining whether the tag is present of Bergman being incorporated into the system of Swartz. In Swartz's system, the consumer is allowed to deactivate the tag by placing positioning the tag in a deactivation region (i.e., by inserting the pin member 130 of the tag into the well 168) (fig. 8a; col. 19, line 59 through col. 20, line 21). Accordingly, Swartz et al as modified by Bergman meets the limitation of the claimed invention.

Appellant's argument with respect to claim 1 that Swartz et al in view of Bergman would change the scope of the Swartz's invention (page 9, line 15 through page 10, line 17) is not persuasive. Swartz discloses a self-checkout system for processing a sales transaction of an article having an attached surveillance tag, each attached surveillance tag bearing a coded indicia, and a method for deactivating the tag. Via scanning the encode indicia attached on the surveillance tag, the surveillance tag is identified before being deactivated by way of an RF field (col. 3, line 50

through col. 4, line 9 and col. 8, lines 48-63). Bergman teaches a system for detecting and deactivating surveillance tag that which is used at a checkout terminal base upon RF detection (col. 3, lines 21-28). Accordingly, Swartz in view of Bergman will not change to scope of the invention of Swartz (i.e., identify the surveillance tag before deactivating in a self-checkout system), but will improve the Swartz's system for identifying/deactivating a surveillance tag by providing Swartz with a faster and more accurate system for identifying the tag (i.e., RF signals verse barcode scanning).

Appellant's argument with respect to claim 1 that Swartz et al in view of Bergman would "... render Swartz inoperable for its intended purpose... If the Bergman device is used before the Swartz device, then the Bergman device deactivates the tag before it can be optically scanned and Swartz is inoperative for its intended purpose of verifying the optical code prior to allowing deactivation. If the Bergman device replaces the Swartz device, then there is no optical scanning whatsoever..." (page 11, lines 1-11) is not persuasive. As noted above, only the step of detecting whether the tag is present of Bergman (i.e., not a whole deactivating system) being incorporated into the system of Swartz et al. Swartz et al in view of Bergman would render Swartz et al operable for its intended purpose as follow: a consumer scan the barcode 124 of a tag 122, which attached to a garment 120 via a scanner 144 (Swartz et al: fig. 7a); detect/determine whether the item has an active surveillance tag (Bergman: fig. 4a); advise/allow the consumer to deactivate the surveillance tag via a surveillance tag deactivator (i.e., by inserting the pin member 130 of the tag into the well 168) (Swartz et al: fig. 8a; col. 19, line 59 through col. 20, line 21).

B. Second Claim Grouping: Appellant contends with respect to claim 4, which is directed to a method of determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation.

With respect to the Appellant's statement that "... the Examiner has failed to state where in the cited art of the limitation added by claim 4 may be found" (page 12, lines 19-20), the examiner respectfully regret for this unintended matter. However, Bergman teaches a step of rechecking the surveillance tag is made to whether a tag intended to be deactivated is not deactivated (col. 3, lines 30+).

Appellant's argument with respect to claim 4 that no motivation to combine Swartz and Bergman (page 13, lines 2+) is not persuasive. Swartz et al discloses a lamp 84 may be illuminated when a successful tag deactivation has occurred (col. 14, lines 65-66). Swartz et al is silent with respect to a step of determining whether the surveillance tag has been deactivated after the step of allowing deactivation. Bergman teaches a step of rechecking the surveillance tag is made to whether a tag intended to be deactivated is not deactivated (col. 3, lines 30+). According, one of ordinary skill in the art would have recognized the addition (i.e., incorporating the step of checking the surveillance tag again after deactivating process of Bergman into the system as taught by Swartz et al (i.e., after a deactivating process performed by the consumer) in order to provide Swartz with a capability of assuring that an active surveillance tag, which attached to a paid item is deactivated before brought out of the store in the event the lamp is malfunctioning (i.e., illuminating when an unsuccessful deactivation occurs), and thus eliminates fault detection (i.e., failure to deactivate a tag in an active state would set off an alarm when passing through a controlled exit).

C. Third Claim Grouping: Appellant contends with respect to claim 5, which is directed to a method of utilizing a second surveillance tag detector for determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation.

Appellant's argument with respect to claim 5 that "... In the event the intended deactivation has not occurred, the device of Bergman either alerts the customer or attempts to deactivate the tag again... Thus, a second detector is not needed..." (page 14, lines 16-19) is not persuasive. As recited in claim 5, "The method of claim 4, wherein the step of determining whether the electronic article surveillance tag has been deactivated includes the step of utilizing a second electronic article surveillance detector." Accordingly, a second surveillance detector is used for determining whether the electronic article surveillance tag has been deactivated (claim 5) after the step of allowing deactivation of the surveillance tag (i.e., performed by the consumer) after determining that the item includes the electronic article surveillance tag (claim 4). Swartz as modified by Bergman teaches a step of rechecking the surveillance tag is made to whether a tag intended to be deactivated is not deactivated with one detector system (Bergman: col. 3, lines 30+). Swartz as modified by Bergman is silent with respect to a step of rechecking the surveillance tag is made by utilizing a second surveillance detector. Bellis teaches self-checkout system having a first electronic article surveillance tag detector/deactivator 230 (i.e., the surveillance tag must be detected in order to deactivated) (fig. 1; page 2, paragraph [0019]); a second electronic article surveillance tag detector 300, which is associated with a bagwell area 270 and a security scale 29, respectively (fig. 1; page 2, paragraph [0020]). Accordingly, one of ordinary skill in the art would have recognized the addition (i.e., incorporating a second electronic article surveillance detector, which being disposed at different location from the first detector) as taught by Bellis into the checkout system of Swartz/Bergman in order to provide Swartz/Bergman with a capability of detecting the electronic article surveillance tag at different place in the system to assuring that an active surveillance tag, which attached to a paid item is deactivated before brought out of the store in the event the lamp is malfunctioning (i.e., illuminating when an unsuccessful deactivation

occurs), and thus eliminates fault detection (i.e., failure to deactivate a tag in an active state would set off an alarm when passing through a controlled exit).

D. Fourth Claim Grouping: Appellant contends with respect to claim 8, which is directed to a self-checkout system having an electronic article surveillance tag detection and deactivation.

Appellant's argument with respect to claim 8 that "...claim 8 differs from claim 1 in that claim 8 does not include a limitation related to allowing a customer to deactivate an EAS tag after detecting the presence of the tag. Accordingly, claim 8 is allowable over the prior art for all of the reasons set forth above with respect to claim 1, ..." (page 16, lines 17-20) is not persuasive. Bergman teaches after detecting a present of a surveillance tag, the system automatically deactivates the detected tag (figs. 4a and 4b; col. 3, lines 57+). Also please prefer to the response to Appellant's argument with respect to claim 1 above.

E. Fifth Claim Grouping: Appellant contends with respect to claim 10, which is directed to a system for determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation.

Please prefer to the response to Appellant's argument with respect to claim 5 above.

F. Six Claim Grouping: Appellant contends with respect to claim 15, which is directed to a self-checkout system having an electronic article surveillance tag detection and deactivation.

Please prefer to the response to Appellant's argument with respect to claim 1 above.

G. Seventh Claim Grouping: Appellant contends with respect to claim 17, which is directed to a system for determining whether the electronic article surveillance tag has been deactivated after the step of allowing deactivation.

Please prefer to the response to Appellant's argument with respect to claim 5 above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Uyen-Chau N. Le
October 24, 2004

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